

## REMARKS

The Examiner is thanked for the clarity and conciseness of the Office Action, and for the citation of references, which have been studied with interest and care.

This Amendment is in response to the Office Action mailed March 26, 2003. In the Office Action, the Examiner objected to the (i) specification and rejected (i) claims 1-33 under 35 U.S.C. §103.

Applicant has cancelled claims 2, 13, and 24 and has amended claims 1, 12, and 23. Reconsideration of the rejections set forth in the Office Action is respectfully requested.

### I. SPECIFICATION

The Office Action objected to the Specification stating that the Title was not descriptive. In response, Applicant has provided a new more descriptive Title, and respectfully requests the withdrawal of this objection.

### II. REJECTION UNDER 35 U.S.C. § 103

The Examiner rejected claims 1-33 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,236,990 issued to Geller, et al. (Geller) in view of U.S. Patent No. 5,987,457 issued to Ballard (Ballard).

*A prima facie* obviousness rejection requires that three basic criteria be met. First, there must be some teaching, suggestion, or motivation, either in the references themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or to combine the references. Second, there must be some reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both

be found in the prior art, and not based on the Applicant's disclosure. MPEP § 2142; In re Vaeck, 947 F. 2d. 488 (Fed. Cir. 1991).

Further, as aptly stated by the Federal Circuit in *In re Kotzab*, 55 U.S.P.Q.2D (BNA) 1313, 1316-1317 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant...

Applicants respectfully submits that amended independent claims 1, 12 and 23 are not rendered obvious by Geller in view of Ballard, because even if Geller and Ballard were combinable, there combination would still not teach or suggest the limitations of amended independent claims 1, 12, and 23. Applicant has amended independent claims 1, 12, and 23 to further clarify the invention.

Applicant's amended independent claims 1, 12, and 23 all basically recite: creating a plurality of categories wherein each category identifies an attribute...associating products having at least one attribute with at least one category...and *upon selection of a main product by a user in communication with a visual browser via a computer network, automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user.*

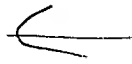
On the other hand, Geller teaches a very different invention and does not teach or suggest the claim limitations of amended independent claims 1, 12, and 23. As stated in Geller, Geller discloses:

A method and system stores a product catalog, which includes product names and can include a category for each product. Attributes for each product category are identified and products within each category are

evaluated by experts who can compare each of the products and how they rate with respect to each attribute. Each of the products in each category is rated for compliance with the attributes identified, for example using a 100-point scale, and the ratings are stored. The user is prompted to select a category. *For the category selected, stored prompts are provided to the user, allowing the user to weigh the importance of each attribute, and this preference information is stored.* The preference and rating information stored is used to rank each product within the category and *provide the ranking to the user*, tailored to the preferences of the user. The user can change a preference and recalculate the rankings based on the new preference information. The user can obtain additional evaluation information, and can order the product. The catalog, attributes, prompts and evaluation information is remotely updatable. (Geller, Column 2, lines 17-37, emphasis added).

As detailed above, in Geller, a user selects a category and for the category selected *stored prompts are provided to the user allowing the user to weigh the importance of each attribute*, and rankings are provided to the user. Ballard is merely cited to provide a reference showing that a computer connected through a computer network can cause the display of a document searched for by a user.

Applicant respectfully submits that clearly the combination of Geller and Ballard does not teach, suggest, or render obvious Applicant's amended independent claims 1, 12, and 23 which recite limitations directed to upon selection of a product by a user in communication with a visual browser via a computer network, automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user.

In fact, Geller teaches a user selecting a category and providing prompts to the user to allow the user to weigh the importance of each attribute, which actually teaches away from  Applicant's invention wherein a plurality of categories are automatically created and each category identifies an attribute... products having at least one attribute are associated with at least one category... and upon selection of a main product by a user in communication with the visual browser via a computer network, automatically displaying a plurality of related products having

*at least one attribute in common with the main product that are selectable for purchase by the user.*

More importantly, nowhere do either Geller or Ballard teach, suggest, or render obvious upon selection of a main product by a user in communication with the visual browser via a computer network, automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user.

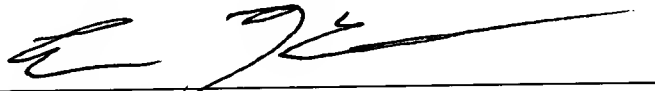
Based on the foregoing, Applicant respectfully submits that there is no teaching or suggestion in either Geller, Ballard, or the combination thereof, of the claim limitations of Applicant's amended independent claims 1, 12, and 23. Quite simply, Applicant's claim limitations are not taught or suggested by either of these references. Accordingly, Applicant respectfully requests that Applicant's amended independent claims 1, 12 and 23 be allowed. Further, Applicant's dependent claims are allowable for being dependent upon allowable base claims.

### CONCLUSION

In view of the remarks made above, it is respectfully submitted that pending claims 1, 3-12, 14-23, and 25-33 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP



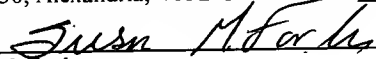
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Dated: July 25, 2003

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### CERTIFICATE OF MAILING

*I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on: July 25, 2003.*

  
Susan McFarlane Date 7/25/03